

REMARKS/ARGUMENTS

Reconsideration and allowance in view of the following remarks are respectfully requested.

Claims 1-3, 5-10, 15-20 remain pending. Claims 3, 5 and 7-9 stand withdrawn from further consideration as directed to non-elected species.

Claim 18 was rejected under 35 USC 102(e) as allegedly being anticipated by Badeau et al. Applicant respectfully traverses this rejection.

Anticipation under Section 102 of the Patent Act requires that a prior art reference disclose every claim element of the claimed invention. See, e.g., Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F.2d 1565, 1574 (Fed. Cir. 1986). While other references may be used to interpret an allegedly anticipating reference, anticipation must be found in a single reference. See, e.g., Studiengesellschaft Kohle, G.m.b.H. v. Dart Indus., Inc., 726 F.2d 724, 726-27 (Fed. Cir. 1984). The absence of any element of the claim from the cited reference negates anticipation. See, e.g., Structural Rubber Prods. Co. v. Park Rubber Co., 749 F.2d 707, 715 (Fed. Cir. 1984). Anticipation is not shown even if the differences between the claims and the prior art reference are insubstantial and the missing elements could be supplied by the knowledge of one skilled in the art. See, e.g., Structural Rubber Prods., 749 F.2d at 716-17.

The Examiner characterizes Badeau as disclosing in Figure 11 that the two radially outer most cells are blocked. It is respectfully submitted, however, that Badeau does not meet the limitations of applicant's claim 18. Claim 18 does not merely require that the two radially outermost cells be blocked. Indeed, in the final paragraph, claim 18 further requires that the peripheral heat-retaining layer be formed by blocking entire cells in the peripheral area only on the exhaust gas inlet side and that the cells on the

peripheral area are not blocked on the exhaust gas outlet side of the monolithic structural body.

The Examiner cites Figure 11 of Badeau in his rejection. However, Figure 11 discloses that the entire cells in the outermost peripheral area are blocked on the exhaust gas outlet side. See in this regard the exhaust gas outlet side of Figure 11 where the outer peripheral cells (shown at the top and bottom) are blocked. This is further specifically described in column 4, lines 32-36 where it is explained that double plugs are provided in the Figure 11 embodiment, sealing both the upstream and downstream ends of the radially outermost flow channels. Thus, the Figure 11 embodiment relied upon by the Examiner does not anticipate applicant's claim 18 because there is no teaching or suggestion of blocking entire cells on the gas inlet side only as recited therein. It is further respectfully submitted that it would be unobvious to omit the downstream blockage of Badeau because Badeau's disclosure in column 4 specifically teaches this feature as advantageous according to Badeau's invention. In view of the foregoing, reconsideration and withdrawal of the rejection of claim 18 is solicited.

Claims 19-20 were rejected under 35 USC 103(a) as allegedly being unpatentable over Badeau in view of legal precedent. Applicant respectfully traverses this rejection.

Claims 19 and 20 are submitted to be patentable over Badeau for the reasons advanced above. Indeed, Badeau does not meet the limitations of claim 18, but rather teaches away therefrom. Therefore the invention claimed in claim 18 is not anticipated by nor obvious from Badeau. For the same reasons, claims 19 and 20 are patentable over Badeau.

Claims 1, 2, 6 and 15-17 were rejected under 35 USC 103(a) as being unpatentable over Kuwamoto et al in view of legal precedent. Applicant respectfully traverses this rejection.

Claim 1 is directed to an exhaust gas cleaning system comprising a particulate filter in which cells are blocked alternately with filler on an exhaust gas inlet side or an exhaust gas outlet side and a peripheral heat-retaining layer, formed by blocking the cells in a peripheral area having a width not less than 5 mm. Claim 1 further provides that the peripheral heat retaining layer is formed by blocking the entire cells in the peripheral area only on an end surface of the exhaust gas inlet side, not on the exhaust gas outlet side and not between the exhaust gas inlet side and the exhaust gas outlet side.

Badeau discloses an exhaust gas filter and purifying method wherein the radially outer most cell in a peripheral area of the filter is blocked on the exhaust gas inlet side. Although the blockage may be limited to the exhaust gas inlet side, Kuwamoto clearly discloses that among the alternately blocked cells, only the outer most peripheral unblocked cell is blocked at the exhaust gas inlet side with sealing material 5. The purpose of providing peripheral sealing material 5 according to the Kuwamoto disclosure is to reduce the quantity of particulates accumulated near the outer peripheral wall, to prevent insufficient combustion of the particulates during regeneration and permit prevention of clogging of the exhaust gas filter (see column 3, lines 65-column 4, line 15 of Kuwamoto). In this regard, Kuwamoto provides second sealing portion 5 only adjacent to the outer peripheral wall for preventing particulate matter from flowing through a through hole at the outer wall. See in this regard Figure 2 of Kuwamoto and the disclosure at column 7, lines 18-37. As clearly understood from Kuwamoto's disclosure, only otherwise open cells at the peripheral wall are filled with material 5. Thus, according to Kuwamoto's teaching the blocked cells occupy a width of less than 5 mm in Kuwamoto, as noted in the February 15, 2006 response, and there are many areas, as understood from Kuwamoto's Figure 2, wherein an open cell is immediately adjacent the outer peripheral wall (see the vicinity of reference numeral 4 therein). Also important, however, is the differing purpose between the Kuwamoto blocked cells and those of the invention. As noted, Kuwamoto provides the sealing

portion 5 in order to "reduce the quantity" of particulate accumulated near the outer peripheral wall and to "prevent insufficient combustion" of [those] particulates during regeneration.

In contrast, a purpose of the present invention is to provide a heat-retaining layer with a heat-retaining effect in a peripheral portion of the DPF. Thus, according to the invention temperature increasing performance is improved and temperature of a filter portion of the DPF is increased evenly during regeneration of the DPT, as explained on page 3, lines 15-20.

The Examiner acknowledges that Kuwamoto does not disclose blocking a width of not less than 5 mm as recited in clam 1. Recognizing this deficiency of Kuwamoto with respect to applicant's claims, however, the Examiner asserts that the claimed minimum width "would have been obvious to one having ordinary skill in the art... to provide a specific optimum range of the peripheral heat-retaining layer width". It is respectfully submitted, however, that it is applicants who proposed a peripheral heat-retaining layer. This is not what Kuwamoto discloses. In the absence of applicant's disclosure, the skilled artisan seeking to "optimize" Kuwamoto would seek to further Kuwamoto's objectives. Since nothing is mentioned therein regarding applicant's inventive object there would be no optimization of a peripheral heat-retaining layer width.

Since Kuwamoto seeks only to reduce the quantity of particulates accumulated near the outer peripheral wall, it is respectfully submitted that the skilled artisan would consider Kuwamoto's teachings to satisfactorily achieve this object and there is no suggestion in Kuwamoto or the remaining art of record that blocking more than the single outermost peripheral open cell Kuwamoto suggests would be necessary or desirable.

It is therefore respectfully submitted that the skilled artisan, without the benefit of applicant's disclosure, would not be motivated to modify Kuwamoto and would

certainly not seek to optimize "a peripheral heat-retaining layer width". On the contrary the skilled artisan would adopt the clear teachings of Kuwamoto of blocking only the outer most peripheral wall open cells.

In view of the foregoing, it is respectfully submitted that the Examiner has not established proper motivation nor any guidance for the skilled artisan in optimizing or otherwise modifying Kuwamoto and is therefore respectfully submitted that the invention is not obvious from the applied art.

It is clear that the initial burden of establishing a basis for denying patentability to a claimed invention rests upon the Examiner. In *re* Piasecki, 745 F. 2d 1468, 223 USPQ 785 (Fed. Cir. 1984). In establishing a prima facie case of obviousness under 35 U.S.C. § 103, it is incumbent upon the Examiner to provide a reason why one of ordinary skill in the art would have been led to arrive at the claimed invention from the prior art. *Ex parte* Clapp, 227 USPQ 972 (BPAI 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from applicant's disclosure. See, for example, *Uniroyal, Inc. v. Rudkin-Wiley Corp.* 837 F.2d 1044, 7 USPQ 2d 1434 (Fed. Cir. 1988).

Rejections based on 35 USC §103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The Examiner has initial duty of supplying the factual basis for the rejection. The Examiner may not resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis. See *In re* Wanery, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967).


In view of the foregoing, reconsideration and withdrawal of the rejection based on Kuwamoto is solicited.

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All objections and rejections having been addressed, it is respectfully submitted that the present application is in condition for allowance and an early Notice to that effect is earnestly solicited.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: 
Michelle N. Lester
Reg. No. 32,331

MNL:slj
901 North Glebe Road, 11th Floor
Arlington, VA 22203-1808
Telephone: (703) 816-4000
Facsimile: (703) 816-4100